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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,092	02/10/2006	Sang-Kee Kim	409-013	7766
96/056	7590	04/05/2011		
Florek & Endres PLLC 1156 Avenue of the Americas Suite 600 New York, NY 10036				
EXAMINER				
WALKER, NED ANDREW				
ART UNIT		PAPER NUMBER		
3781				
MAIL DATE		DELIVERY MODE		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/568,092

**Applicant(s)**

KIM, SANG-KEE

**Examiner**

NED A. WALKER

**Art Unit**

3781

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 November 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3,5,9,12,14 and 15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3,5,9,12,14 and 15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 February 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Specification*

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter (37 CFR 1.75(d)(1) and MPEP §608.01(o)) with respect to the Amendment filed November 9<sup>th</sup>, 2010. Correction of the following is required:

Amended Claims 3 and 15 comprise the limitation “adapted to *independently engage* an outer surface of a container being covered when in the second position, and wherein said container cover is *sized and shaped to fit a plurality of differently sized and shaped containers*” (emphasis added).

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. **Claims 3, 5, 9, 12, 14, and 15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.**

Claims 3 and 15 contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the amendment filed November 9<sup>th</sup>, 2010 comprises the limitation “adapted to *independently engage* an outer surface of a container being covered when in the second position, and wherein said container cover is *sized and*

*shaped to fit a plurality of differently sized and shaped containers"* (emphasis added).

The Examiner could not find written description support for this limitation in the originally filed disclosure.

Claims 5, 9, 12, and 14 are rejected for incorporating the errors from their respective parent claim by dependency.

**4. Claims 3, 5, 9, 12, 14, and 15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.**

Claims 3 and 15 contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, the amendment filed November 9<sup>th</sup>, 2010 comprises the limitation "adapted to *independently engage* an outer surface of a container being covered when in the second position, and wherein said container cover is *sized and shaped to fit a plurality of differently sized and shaped containers"* (emphasis added). The Examiner could not find enabling support for this limitation in the originally filed disclosure.

Claims 5, 9, 12, and 14 are rejected for incorporating the errors from their respective parent claim by dependency.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**6. Claims 3, 5, 9, 12, 14, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by McMann (US Pat. No. 1,857,853).**

McMann discloses a container cover (FIGS. 1-2) comprising: a cover plate (19) having a rear surface (lower surface of 19 in FIG. 2); and a closing member (17, 18) having two fixing portions (20, 21) fixed to the cover plate, wherein a first fixing portion (21) is fixed to the cover plate along a peripheral portion of said rear surface of said cover plate (FIG. 2) and a second fixing portion (20) is fixed to the cover plate along a peripheral portion of a second surface of the cover plate (top surface of 19 in FIG. 2), and wherein said closing member includes an annular contact portion (26) integrally formed along a peripheral portion of said two fixing portions (this peripheral portions is considered to be the outer vertically disposed peripheral skirt portion extending from 21 to 22 and integrally formed with top of 26), wherein said annular contact portion is adaptable from a first position wherein it is bent from the two fixing portions toward said second surface (column 2 lines 30-35 disclose body portion 17, 18 is "formed of an elastic material of rubber or suitable rubber composition" and therefore it is capable of assuming this method of use orientation) and extending integrally therefrom to a second position wherein it is bent from the two fixing portions toward said rear surface (column 2 lines 30-35 disclose body portion 17, 18 is "formed of an elastic material of rubber or suitable rubber composition" and therefore it is capable of assuming this method of use orientation); wherein said annular contact portion includes an end having at least one protrusion (22) extending from said end and adapted to independently engage an outer

surface of a container being covered when in the second position (FIG. 2), and wherein said container cover is sized and shaped to fit a plurality of differently sized and shaped containers (FIGS. 1-2; column 3 lines 40-50); wherein the cover plate has a round formed at a side end of the cover plate along its lower peripheral portion (portion of 19 adjacent 23 in FIGS. 2); wherein no part of said contact portion extends integrally farther than any other part of said contact portion (FIG. 2); wherein said annular contact portion lies essentially parallel to said second surface when said annular contact portion is in the first position (column 2 lines 30-35 disclose body portion 17, 18 is "formed of an elastic material of rubber or suitable rubber composition" and therefore it is capable of assuming this method of use orientation); wherein said contact portion is integrally connected to both fixing portions (integral to the junction between 20 and 21 as shown in FIG. 2 and therefore either directly or indirectly integrally connected).

### ***Response to Arguments***

**7. Applicant's arguments, see amendment filed November 9<sup>th</sup>, 2010, with respect to the contention that "[n]o new matter is added by these amendments," have been fully considered, but are not persuasive.**

The Applicant argues that support for the additional subject matter added to the claims "can be found in Claims 11 and 13 as well as in the application, inter alia, ¶¶ 0001, 0009, and 0021." As a preliminary matter, the Examiner notes the Applicant must refer to the original Specification document filed as part of the original disclosure when citing support for amended subject matter; the Specification of the original disclosure does not include the aforementioned paragraph numbers cited for support.

The Examiner assumes that the Applicant is referring to the US-PGPUB version of the original disclosure which does not constitute an official original disclosure and therefore such citation is improper; however, for purposes of expedited efficiency the Examiner will consider the subject matter of these US-PGPUB paragraphs accordingly under this assumption. Claim 13 can be immediately excluded as adequate support for newly added subject matter because said Claim was not presented in the original disclosure. Neither the Applicant's support, that is Claim 11 and the aforementioned paragraphs, nor the overall disclosure taken as a whole, provide adequate support for the amended language "adapted to *independently engage* an outer surface of a container being covered when in the second position, and wherein said container cover is *sized and shaped to fit a plurality of differently sized and shaped containers*" (emphasis added). The Examiner could not locate any original disclosure language setting forth the independent engagement of any part and the cover being sized and shaped to fit a plurality of differently sized and shaped container. The Examiner notes that the latter recitation goes beyond the cited support of "said container cover can be applied to a container irrespective of the type or size of the container" because this alleged support makes no mention of the cover being "sized and shaped to fit" which is a narrower recitation of the broad support merely stating that the cover "can be applied."

**8. Applicant's arguments, see amendment filed November 9<sup>th</sup>, 2010, with respect to the rejection of Claims 3, 5, 9, 12, 14, and 15 under 35 USC §102(b) as being anticipated by McMann (US Pat. No. 1,857,853), have been fully considered, but are not persuasive.**

In response to Applicant's argument that "McMann does not teach a container cover wherein the annular contact portion can have a protrusion that independently engages an outer surface of a container to be covered" (emphasis original), the Applicant is reminded that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The courts have held an apparatus's claims covers what a device is, not what a device does. A claim containing a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus if the prior apparatus teaches all the structural limitation of the claims. In *re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d, 1429, 1431-.2 (Fed. Cir. 1997); *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990); *Ex parte Masham*, 2 USPQ 2d 1647 (Bd. Pat. App. & Inter. 1987). Furthermore, it has been held that a recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense (*In re Hutchison*, 69 USPQ 138). While the examiner appreciates Applicant's opinion regarding the new limitations, the Examiner is not convinced that the manner in which substantially all the limitations of the claim(s) are intended to be employed differentiates the claimed apparatus from the prior art.



In response to Applicant's argument that "McMann does not teach a container cover wherein the annular contact portion can have a protrusion that independently engages an outer surface of a container to be covered" (emphasis original), the Applicant is reminded that the Examiner must give the claims their broadest reasonable interpretation. Claims in a pending application should be given their broadest reasonable interpretation. *In re Pearson*, 181 USPQ 641 (CCPA 1974). The term "independent" is defined as "not dependent; not depending or contingent upon something else for existence, operation" (independent. *Dictionary.com Unabridged*. Random House, Inc. <http://dictionary.reference.com/browse/independent>); therefore, because McMann's feature 22 engages the outer surface of the container 16 without being contingent upon any other feature engaging 16, it can be interpreted to "independently engage" such surface. Furthermore, the McMann language cited by the Applicant does not impede the reference from anticipating this broad definition. Instead the Examiner has applied an overly limiting interpretation to the term.

In response to Applicant's argument that "McMann relies on an interaction between the protrusion and an undercut or shoulder of the container in order to be attached to the container....[therefore] McMann's cover can only engage a container for which it was specially made," the Examiner points out that the logic of this argument relies on the unsubstantiated premise or assumption that any such interaction must mean the cover can only engage a container which is specially made. There is no evidence or support in the McMann reference to substantiate this premise. Furthermore, as now noted in the prior art rejection *supra*, McMann states "[t]he

elasticity or compressibility of the flange permits of its compensating for any inequalities in...the container" (column 3 lines 40-50) sufficiently anticipates that the cover is capable of fitting differently sized and shaped containers.

In response to Applicant's argument that the McMann fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "capable of engaging a container irrespective of the size and shape of the container") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to Applicant's argument that McMann includes additional structure not required by Applicant's invention, it must be noted that McMann discloses the invention as claimed. The claims in the instant application are written using the transitional phrases "comprising" and "consisting essentially of". The fact that it discloses additional structure not claimed by the Applicant is irrelevant since it does not materially affect the basic and novel characteristics of the claimed invention. See MPEP § 2111.03.

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to NED A. WALKER whose telephone number is (571)270-3545. The examiner can normally be reached on Mon. - Fri. 7:30 AM - 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Stashick can be reached on 571-272-4561. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Anthony Stashick/  
Supervisory Patent Examiner, Art  
Unit 3781

NW